

In re Appln. of CALLINAN et al.
Application No. 09/428,508
Reply to Office Action of August 15, 2003

REMARKS

Claims 11-17, 19-42, 44-48 and 51-72 were pending in the application at the time of the August 15, 2003 Office Action. In the Office Action, 56-62 and 64-71 were rejected and claims 63 and 72 were objected to as being dependent upon a rejected base claim, but were otherwise indicated to be allowable. The balance of the claims were allowed as they stood at the time of the Office Action.

In this response, claims 63 and 72 have been amended to incorporate their respective base claims and are therefore now believed to be in allowable form.

Claims 56-62 and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over French Reference 1,398,975 in view of German Reference 3,513,539. The Examiner argued that the French '975 reference discloses the claimed invention except for the use of cut tires and that the German '539 reference teaches that it is known to provide a retaining wall with cut tires. From this combination, the Examiner argued that it would have been obvious to one of ordinary skill in the art to construct the retaining wall of the rejected claims. Applicants respectfully disagree.

The French '975 reference relates to the construction of gabions, which are a particular type of structure used for preventing erosion. The German '539 reference, however, relates to plant-bearing noise protection walls. The German '539 reference has nothing whatsoever to do with preventing erosion and the French '975 reference has nothing to do with noise protection.

It is the burden of the Patent Office to make a *prima facie* case of obviousness based on this prior art. In particular, Section 2142 of the Manual of Patent Examining Procedure provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

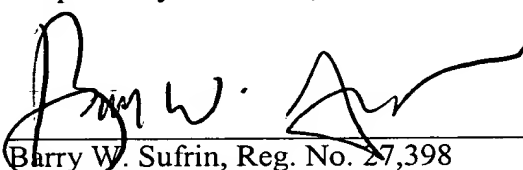
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The present rejection does not present a *prima facie* case of obviousness. The required motivation to combine the French '975 reference and the German '539 reference cannot be found in the references. Furthermore, one skilled in the art of designing or constructing retaining walls for retaining an embankment or similar structure as set out in the rejected claims would not look to the art of plant-bearing noise protection walls for assistance in his work.

Claims 65-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable the French '975 reference in view of the German Reference 3,829,615. The Examiner argued that the French '975 reference teaches the present invention except for the tires being cut in a plane between opposing sidewalls and that the German '615 reference teaches that it is known to provide retaining with the tires being cut in a plane between opposing sidewalls. This rejection is traversed for failing to establish a *prima facie* case of obviousness under the combination of these two references for the reasons advanced above with regard to the rejection of claims 56-62 and 64.

The application is believed to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barry W. Sufrin", is written over a horizontal line.

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